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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,148	12/31/2003	Masaki Okuyama	247103US0	6857

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ALEXANDRIA, VA 22314

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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11/19/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/748,148

Applicant(s)

OKUYAMA ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-10 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Receipt is acknowledged of amendment and remarks file don 10/25/07. Claims 9-10 have been added as per applicant's amendment dated 10/25/07. Claims 1-10 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 103

Claims 1-2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP 2002-154932, machine translated text submitted by applicants (JP '932) and U. S. Patent 6,491,931 ('931).

Instant application is claiming a cosmetic composition comprising:

1. Polypropylene fibers or polypropylene fibers treated with fluorine compound
2. Oil soluble resin

JP '932 teaches eyelash cosmetic using oil soluble resin and fibers treated with fluorine compound. See the abstract, see page 2 paragraph 9 for fibers. The fibers are nylon fibers, rayon fibers, cellulose fibers and polyester fibers. See paragraphs 12-22 for the fibers treated with various fluorine compounds. See paragraphs 6-7 for oil soluble resin. The difference between the JP '932 and instant application is JP '932 does not teach polypropylene fibers treated with fluorine compound. However patent '931 teaches cosmetic composition using fibers and film forming polymer. Film forming polymers are also oil soluble resins. See the abstract; see col.2, ll 5-15 for the length of the fiber. Patent at col.2, ll 15-35 teaches various fibers and teaches equivalency between fibers of JP '931 and claimed polypropylene fibers. Patent '931 at col.2, ll 36-37 teaches that the fibers can be surface treated. See col.3, ll 5 through col.4, ll 27 for the film-forming polymer. See examples drawn to mascara.

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Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of JP '932 using oil soluble resin and substitute fibers treated with fluorine compound of JP with polypropylene fibers and treat these fibers with fluorine compound in view of the equivalency between the fibers of JP and polypropylene fibers taught by patent '931 in mascara compositions. The idea of combining the ingredients flows logically from the art. This is a prima facie case of obviousness.

Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP 2002-154932, machine translated text submitted by applicants (JP '932) and U. S. Patent 6,491,931 ('931) as applied to claims 1-2 and 4 above, and further in view of JP 2002-284642, machine translated text (JP '642).

Both the documents cited above do not teach the limitation, where in the oil soluble resin is obtained by fractionation of candelilla wax. However JP '642 teaches claims 5-6 limitation and using this resin in cosmetics. See paragraphs 1-9. See also paragraph 15.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of JP '932 using oil soluble resin and substitute fibers treated with fluorine compound of JP with polypropylene fibers and treat these fibers with fluorine compound in view of the equivalency between the fibers of JP and polypropylene fibers taught by patent '931 in mascara compositions and use oil soluble resin of JP 642. One of ordinary skill in the art would be motivated to modify the compositions of JP and use polypropylene fibers and use oil soluble resin of '642 with the reasonable expectation of success that the compositions has excellent eyelash curling effect and the presence of specific oil soluble

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resin of claims 5-6 provide the advantage of providing a film that is excellent in adhesion to skin.

This is a prima facie case of obviousness.

Applicants did not present arguments separately for claims (1-2 and 4) & (5-6 and 8), therefore the examiner will also respond similarly.

Response to Arguments

Applicant's arguments filed 10/25/07 have been fully considered but they are not persuasive.

The obviousness rejections under 35 U.S.C. § 103(a) of " (1) Claims 1, 2 and 4 over Kosugi (JP 2002-154932) in view of Collin (U.S. Patent 6,491,931); and (2) claims 5, 6 and 8 over Kosugi in view of Collin and Tanaka (JP 2002-284642), are respectfully traversed.

Applicant argues:

“Neither Kosugi (JP 2002-154932), nor Collin (U.S. Patent 6,491,931) when considered alone or in combination, provide sufficient motivation and guidance to direct a skilled artisan to particularly select the claimed polypropylene fibers from either the tremendously broad genus of synthetic fibers, or the particularly preferred nylon and rayon fibers, described therein. Even if sufficient motivation and guidance is considered to have been provided by and Collin to direct a skilled artisan to particularly select the claimed polypropylene fibers, such a case of obviousness is rebutted by a showing of superior results, as evidenced by the comparative experimental data presented in Table 1 of the present specification, and [Table 1] appended herewith. As shown in these Tables, the nylon fibers of Comparative Example 1, and the rayon fibers of Comparative Example 3, as described in Kosugi and Collin, fail to achieve a sufficient long lash effect

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and suffer from a lack of uniformity. However, the treated polypropylene fibers of Example 1 as presented in Table 1 of the present specification, and the untreated polypropylene fibers as presented in [Table 1] appended herewith, remarkably exhibit excellent long lash effect, long lasting effect, usability and uniformity”.

In response to the above argument, the table 1 is limited to polypropylene fibers treated with silica (0.5%). This corresponds to claim 3 and this claim was not rejected. There is no data with respect to polypropylene fibers treated with fluorine compound (emphasis added). See below for table 1 (page 19 of specification.

No.	Component	Example					Comparative Example			
		1	2	3	4	5	1	2	3	4
(1)Stearic acid		3	3	3	3	3	3	3	3	3
(2)Carnauba wax		5	5	5	1	5	5	6	5	5
(3)Candelilla resin*1		5	5	5	10	1	5	-	5	5
(4)Cetyl alcohol		1	1	1	1	1	1	1	1	1
(5)Purified water		balance	balance	balance	balance	balance	balance	balance	balance	balance
(6)Triethanolamine		1.5	1.5	1.5	1.5	1.5	1.5	1.5	1.5	1.5
(7)Polypropylene fiber*2		2	0.5	5	2	2	-	2	-	-
(8)Polypropylene fiber*3		-	-	-	-	-	-	-	-	2
(9)Nylon fiber*4		-	-	-	-	-	2	-	-	-
(10)Rayon fiber*5		-	-	-	-	-	-	-	2	-
(11)Alkyl acrylate copolymer emulsion*6		40	40	40	40	40	40	40	40	40
(12)Methyl p-hydroxybenzoate		0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5
(13)Chamomile extract		0.1	0.1	0.1	0.1	0.1	0.1	0.1	0.1	0.1
(14)Black iron oxide		8	8	8	8	8	8	8	8	8
(15)Silica*7		5	5	5	5	5	5	5	5	5
Items of evaluation and Results of determination										
a Make-up effect (long lash effect)		00	0	00	00	00	Δ	0	Δ	0
b Long-lasting of make-up effect		00	00	00	00	0	0	x	0	Δ
c Usability of making-up		00	00	0	0	00	0	Δ	0	x
d Uniformity of finished film		00	00	0	00	00	Δ	Δ	Δ	Δ

*1: softening point 47 to 48°C

*2: 6 D, 1 mm, treated with 0.5% silica

*3: 20 D, 4 mm, treated with 0.5% silica

*4: 6 D, 1 mm, untreated

*5: 6 D, 1 mm, untreated

*6: solid content 40%

*7: SYLYSIA 550 (manufactured by Fujii Silysia Chemical Ltd.)

Clarification is requested for table 1 appended with the response. These results are not cited in the specification and the results are not in declaration form. The examiner considered the results. The results are not commensurate with the scope of claims. See table 1 appended with the response.

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[Table 1]

No.	Component	Additional Example 1	Comparative Example 1	Comparative Example 3
(1)	Stearic acid	3	3	3
(2)	Carnauba wax	5	5	5
(3)	Candelilla resin*1	5	5	5
(4)	Cetyl alcohol	1	1	1
(5)	Purified water	balance	balance	balance
(6)	Triethanolamine	1.5	1.5	1.5
(7')	Polypropylene fiber*2	2	-	-
(9)	Nylon fiber*3	-	2	-
(10)	Rayon fiber*4	-	-	2
(11)	Alkyl acrylate copolymer emulsion*5	40	40	40
(12)	Methyl p-hydroxybenzoate	0.5	0.5	0.5
(13)	Chamomile extract	0.1	0.1	0.1
(14)	Black iron oxide	8	8	8
(15)	Silica *6	5	5	5
Items of evaluation and results of determination				
a	Make-up effect (long lash effect)	OO	Δ	Δ
b	Long-lasting of make-up effect	OO	O	O
c	Usability of making-up	OO	O	O
d	Uniformity of finished film	O	Δ	Δ

Extremely favorable: OO Favorable: O Rather unfavorable: Δ Unfavorable: ×

*1: softening point 47 to 48°C.

*2: 6D, 1 mm, untreated

*3: 6D, 1 mm, untreated

*4: 6D, 1 mm, untreated

*5: solid content 40%

*6: SYLSIA 550 (manufactured by Fuji Silysia Chemical Ltd.)

The oil soluble resin in table 1 is specific to candelilla resin (softening point 47-48° C).

The percentage of polypropylene fibers is 2%, and the thickness is 6D and length is 1mm. There

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is no data with respect to claimed polypropylene fiber thickness at the lower and upper limit and also there is no data with respect to length of the fiber at the lower and upper limit claimed in the instant application and the percentage of polypropylene fiber using 0.1% and 10% of untreated polypropylene fiber.

See In re Peterson, 315 F.3d 1325, 1329-31, 65 USPQ2d 1379, 1382-85 (Fed. Cir. 2003) (data showing improved alloy strength with the addition of 2% rhenium did not evidence unexpected results for the entire claimed range of about 1-3% rhenium); In re Grasselli, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983) (Claims were directed to certain catalysts containing an alkali metal. Evidence presented to rebut an obviousness rejection compared catalysts containing sodium with the prior art. The court held this evidence insufficient to rebut the prima facie case because experiments limited to sodium were not commensurate in scope with the claims).

In conclusion, the showing is not commensurate with the scope of claims

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A. VENKAT/ Ph. D

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Primary Examiner
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